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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
POLTORAK, PIOTR	

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/936,768	FUCARILE ET AL.	
	Examiner	Art Unit	
	Peter Poltorak	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-50 have been examined.

Priority

2. A claim for priority has been made in this application based on the continuation in part of applications 09/267269 *(03/12/1999)* and PCT/US00/06242 *(3/10/2000)*.

Specification

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.
5. In claims 9-10 and 27-28 the following lack antecedent basis:
   - Claim 9, 27: "the cache",
   - Claim 10, 28: "the validity".
6. The phrase in claims 9 and 27: "inspecting the cache for a response from the server and requesting the status of the license from the server responsive to the inspection of the cache" are not understood. The terms are treated as best understood.

7. "A license-specific portion" cited in claims 1, 19 and 37 is not understood. The term is treated as best understood.

8. Claims 2-8, 11-18, 20-26, 29-36 and 38-50 are rejected by virtue of their dependence.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-7, 12, 14, 17-26, 30, 32, 35-36, 38-40, 42, and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by *Larose et al. (U.S. Patent No. 6108420).*

10. As per claims 1-2, 5-7 and 19 *Larose et al.* teach files present on an installation computer *(col. 14 lines 25-27),* and examining the files and embedded data *(col. 14 line 66-col. 15 line 1). Larose et al.* teach sending a license-specific portion *(license information)* which is evaluated by a server *(SDA),* and processing the digital content subject to the status *(e.g. free upgrade) (col. 15 lines 1-10).*

11. *Larose et al.* teach the limitations of claim 3 in col. 6 lines 22-24.

12. As per claims 4 and 14 *Larose et al.* teach the data including a portion *(signature)* for determining whether the digital content has been altered *(col. 3 lines 50-56).*

13. As per claim 12 the at least a portion of the digital content is part of the digital content.

14. *Larose et al.* teach the limitations of claims 17-18 in col. 6 lines 38-49.

15. Claims 19-26, 30, 32, 35-36, 38-40, 42, and 50 are substantially equivalent to claims 1-7, 12, 14, 17-18; therefore claims 19-26, 30, 32, 35-36, 38-40, 42, and 50 are similarly rejected.

16. Claims 1-5, 13-14, 15-16 and 19-23, 31-34, 37-40 and 47-49 are rejected under 35 U.S.C. 102(e) as being anticipated by *Horstmann (U.S. Patent No. 6009401).*

17. As per claim 1 *Horstmann* teaches software installation that includes a license certificate *(col. 3 lines 60-62)* stored on a user machine *(col. 3 lines 38-40). Horstmann* teaches checking the license terms *(as shown in Table 1)* and trial parameters *(col. 3 lines 53-56)* and allowing a software trial.

18. As per claim 2 examining the digital content includes searching for a license statement *(License terms within Table 1).*

19. As per claims 3 and 4 the data includes a human readable portion *(name and address of licensee, Table 1)* and encrypted portion *(digital signature, Table1).*

20. As per claims 5 and 13 the license is part of the digital data *(Horstmann, Abstract).*

21. As per claims 15 and 16 *Horstmann* teaches conditional allowance of a software trial *(col. 3 lines 53-55).*

22. Claims 19-23, 31-34, 37-40 and 47-49 are substantially equivalent to claims 1-5, 13-16; therefore claims 19-23, 31-34, 37-40 and 47-49 are similarly rejected.

23. Claims 1, 6, 12, 19, 24, 30, 37 are rejected under 35 U.S.C. 102(e) as being anticipated by *Coley et al. (U.S. Patent No. 5790664).*

24. As per claim 1 and 6 *Coley et al.* teach client application *(digital content)* comprising a client module *(data indicating that the content is subject to a license. It also*

includes IP address of the computer as discussed bellow) that sends enquiry to a license server *(col.4 lines 22-32).* Upon receipt of the license record the application is enabled *(col. 4 lines 44-46).*

Coley et al. teach a license record identifying a license in accordance with a hardware identifier such as an IP address *(col. 4 lines 30-33)* and the request message containing information such as the application information and a hardware identifier, such as the IP address of the computer *(portion of the data indicating that the content is subject to a license) (col. 9 lines 3-8).*

25. As per claim 12, requesting the license status is part of processing the data.

26. Claims 19, 24, 30, 37 are substantially equivalent to claims 1, 6 and 12; therefore claims 19, 24, 30, 37 are similarly rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

27. Claims 8 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larose et al. (U.S. Patent No. 6108420)* in view of *Brachtl et al. (U.S. Patent No. 4908861).*

28. *Larose et al.* teach data comprising an encrypted portion and sending a portion of the data to the server as discussed above. *Larose et al.* do not explicitly teach sending the encrypted portion.

Brachtl et al. teach sending an encrypted portion *(Brachtl et al., Fig. 1).* It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send the encrypted portion as taught by *Brachtl et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to assure process integrity *(Brachtl et al., col. 3 lines 50-54 and col. 4 lines 1-68).*

29. Claims 17-18, 35-36 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Horstmann (U.S. Patent No. 6009401)* in view of *Official Notice.*

30. As per claims 17 and 18 *Horstmann* teaches determining a status of the license as discussed above.

Horstmann does not teach determining a status of the license comprising determining and indicating to a user that the license is for non-commercial use.

31. Official Notice is taken that it is old and well-known that license can be restricted to commercial or non-commercial use and based on the restriction a the licensed material may be utilized differently. It is also old and well-known to indicate to a user that the content is licensed for non-commercial use. One of ordinary skill in the art at the time of applicant's invention would have been motivated to incorporate the determining and indicating to a user that a license is for non-commercial use into *Horstmann's* invention in order to warn the user about the content restrictions.

32. Claims 35-36 and 50 are substantially equivalent to claims 17-18; therefore claims 35-36 and 50 are similarly rejected.

33. Claim 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Horstmann (U.S. Patent No. 6009401)* in view of *Larose et al. (U.S. Patent No. 6108420).*

34. *Horstmann* teaches the portion of the data *(a digital signature, Table 1)* and the digital content as discussed above. *Horstmann* does not teach determining whether the digital content has been altered using the portion data.

Larose et al. determining whether the digital content has been altered using the portion data *(col. 3 lines 43-56).*

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate determining whether the digital content has been altered using the portion data as taught by *Larose et al.* into *Horstmann's* invention. One of ordinary skill in the art would have been motivated to perform such a modification in order to detect the digital content alternation.

35. Claims 7-11, 25-29 and 41-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Coley et al. (U.S. Patent No. 5790664)* in view of *Tootle (U.S. Patent No. 5787174).*

36. *Coley et al.* teach sending a portion of the data *(IP address)* to the server as discussed above.

Coley et al. do not explicitly teach the identifier *(portion of the data)* being encrypted.

Tootle teaches encrypting the identifier *(Tootle, col.5 lines 24-40).*

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to encrypt the identifier as taught by *Tootle* into *Coley et al's* invention. One of ordinary skill in the art would have been motivated to perform such a modification in order to avoid duplicate entries within the license database stored on the license server. (*Using unencrypted hardware identifier to identify a license of the computer such as an IP address (Coley et al. col.4 line 30-32) may produce unexpected results. For example, duplicate IP addresses can be encountered (internal IP address don't have to be unique). Using a private key encryption as taught by Toole ensures that the identifier will be unique.)*

37. Claims 9-11, as best understood, are taught by *Coley et al.* in col. 6 lines 10-53.

38. Claims 25-29 and 41-44 are substantially equivalent to claims 7-11; therefore claims 25-29 and 41-44 are similarly rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/17/05

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